Application No.: 10/814,917
Docket No.: UC0420 US NA

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Remarks

Status of the Application

Claims 1-9 and 13-20 are pending. New claim 20 is added to protect an embodiment of interest to the Applicant. Support for the claim can be found, for example, in Applicant's specification at page 12, lines 13-15. No new matter is added.

Prima Facie Obviousness Not Established

Claims 1-9 and 13-19 were rejected as obvious over US Pat. No. 5,002,700 ("the Otagawa reference"). Applicant traverses the rejection, and respectfully submits that no *prima facie* case of obviousness was established.

To summarize, Claim 1, the sole independent claim, claims an aqueous dispersion of 1) certain conductive polymers doped with non-polymeric organic acid anion(s) and 2) colloid-forming polymeric acid(s). As admitted by the Examiner, this is not disclosed by the Otagawa reference.

The MPEP states: "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *Id.* at §2142 ("To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."). The Office Action has failed to factually support the rejection.

For example, the Office Action states "[i]n essence, the disclosure of the reference differs from the claimed invention in not expressly disclosing a combination of dopants ...". *Office Action* at page 3, first para. The MPEP reminds Examiners that "[d]istilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" *Id.* at §2141.02. The risk to the patent system is that the resulting analysis then becomes of a conclusory nature.

Applicant submits that the Office Action's statement [*loc. cit.*] that "it would have been obvious ... to employ a mixture of dopants, reading on said presently [*sic*] materials, for their expected additive effect" is precisely the type of analysis that the Patent Office seeks to avoid. What evidence has the Examiner provided that the reference suggests "mixture[s] of dopants"?

PAGE 7/9 * RCVD AT 10/16/2006 3:32:25 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/7 * DNIS:2738300 * CSID:302 892 1026 * DURATION (mm-ss):02-20

Or, if it is alleged to be general knowledge, what evidence has the Examiner provided that a mixture has any more additive effect than merely increasing the amount of a single dopant?

Under the circumstances, the combination of dopants could improve the situation, make it worse, or not change things at all. The Examiner has provided no *evidence* that one outcome is any more likely than another. The MPEP states that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." MPEP §2144.03. Similarly, absent Applicant's discovery that the presently claimed compositions are desirable, the Examiner would have no direction to arrive at the proposed modification. *See In Re Kahn,* 441 F.3d 977, 986 (Fed. Cir. 2006) ("The use of hindsight is inferred if an explanation is not provided of the motivation, or the suggestion or teaching, that would have led a skilled artisan at the time of the invention to the claimed combination as a whole."). Accordingly, the rejection is improper as lacking suggestion and motivation.

The rejection is also improper as failing to teach or suggest all claim limitations. Each rejected claim requires a showing of *why* it is obvious. A few examples are discussed below.

Claim 1 requires "an aqueous dispersion of at least one conductive polymer and at least one colloid-forming polymeric acid, wherein the electrically conducting polymer is doped with at least one non-polymeric organic acid anion." Applicant submits that the failure of the Examiner to explain with reasonable specificity the suggestion or motivation to arrive at this limitation procedurally fails to establish a *prima facie* case of obviousness.

The Otagawa reference's claim fifteen states that "wherein the electropolymerization is performed at a pH of between about 0.65 and 1." In contrast, Applicant's Claim 2 recites the "pH of the dispersion is between 1 and 8." The Examiner should address these differences in a proper rejection. The difference is not trivial; for example, the Applicant's specification states that "[i]t is frequently desirable to have a higher pH, as the acidity can be corrosive." *Id.* at page 14, lines 35-36.

Claim 16 recites " an aqueous dispersion comprising electrically conductive polypyrrole/non-polymeric acid dopant and polymeric perfluroethylenesulfonic acid, wherein the aqueous dispersion has a pH greater than 2 and a weight ratio of polymeric perfluroethylenesulfonic acid to polypyrrole +non-polymeric acid anion greater than 1." The

PAGE 8/9 * RCVD AT 10/16/2006 3:32:25 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/7 * DNIS:2738300 * CSID:302 892 1026 * DURATION (mm-ss):02-20

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Examiner has not taken any steps to show how this is obvious.

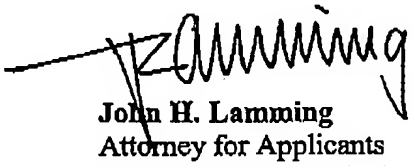
The MPEP requires that "[w]ith regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not." MPEP §2142. The Office Action does not provide the required facts or evidence to establish a *prima facie* case of obviousness.

Conclusion

Applicant respectfully submits that the obviousness rejections should be explained if they are to be reapplied to the pending claims. Applicant solicits a notice of allowance for claims 1-9 and 13-20.

Should the Examiner have questions about the application or the contents of this paper, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,



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PAGE 9/9 * RCVD AT 10/16/2006 3:32:25 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/7 * DNIS:2738300 * CSID:302 892 1026 * DURATION (mm-ss):02-20